

REMARKS

Claims 1-5, 7-16, 25-27, 30-31, and 33-34 remain in the application for further prosecution.

I. THE 35 U.S.C. § 102 REJECTION

Claims 1-2, and 4 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hino *et al.* (US 2002/0162724) (“Hino”). Reconsideration and withdrawal of this rejection is requested.

The Examiner alleges that Hino discloses a “dampening mechanism (See FIG. 4 below, C and 122a); coin receptacle station (120); first end (See FIG. 4 below, C); housing (110); second end (See FIG. 4 below, Back Side (opposite Front Side) of 122a)” (*see* Office Action, page 6). Thus, the asserted “dampening mechanism” is simply a front wall 122a of the drawer 122 (*see* par. [0136]). The front wall 122a serves to stop movement of the drawer 122 at a predefined point upon insertion of the drawer into the coin processing unit 110 housing.

In the Examiner’s remarks, the Examiner maintains that, regarding Hino, “[i]n the closing operation there is a damping force exerted.” Applicant maintains that the drawer 122a and backstop C do not “*exert a damping force*” on the storage unit 120 during movement of the storage unit between the first position and the second position, wherein the storage unit is “disposed entirely within the housing for receiving coins when in the first position” and wherein the storage unit is “extending out of the housing when in the second position.” The front wall 122a and backstop C, even when taken in combination, are not capable of, nor do they disclose or suggest, the recited element.

The Examiner also stated that “Claim 1 does not state in what direction the dampening force is exerted or in what operation (closing or opening).” It is fundamental patent law that the claim language may not be construed in a manner inconsistent with the description of the

invention in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005) (*en banc*). To interpret the full scope and content of the method Appellant claims, one looks first to the claim language itself. *Phillips v. AWH Corp.*, 415 F.3d at 1312-13. Should the language of the claims appear ambiguous, one looks to the specification for enlightenment, clarification, and definition. *Id.* at 1313-16. The specification is the primary basis for construing the claims. *Id.* at 1315. Further, it is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the “ordinary” and the “customary” meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls, Div. Of Dover Resources, Inc. v. Mega Systems, LLC*, 350 F.3d 1327, 1338, (Fed. Cir. 2003). Paragraph [0037] of Applicant’s disclosure notes a “dampening mechanism is attached to the receptacle station 304 for controlling the speed at which the receptacle station 304 travels as it travels into and out of the housing 302” and that “[t]he damping mechanism . . . prevents the moveable receptacle station 304 from traveling too rapidly into and out of the housing 302.” The Examiner’s interpretation of the claims is wholly improper.

Notwithstanding the Examiner’s factual error and misapplication of the law, Applicant is further amending the claim to make more explicit that which is already claimed (i.e., to recite from the first position to the second position and from the second position to the first position) to ensure that there can be no misinterpretation, to expedite prosecution, and/or to place the claims in even better form for appeal. The Examiner cannot reasonably argue that Hino discloses “a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and from the second position to the first position.” Withdrawal of this rejection is requested.

II. THE 35 U.S.C. § 103 REJECTION OF CLAIM 3

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Jones *et al.* (US 6,318,537) (“Jones”). Reconsideration and withdrawal of this rejection is requested.

Claim 3 recites coin processing device comprising, *inter alia*, “a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and from the second position to the first position.” As noted above, even as Hino is construed by the Examiner, Hino cannot be reasonably said to disclose or suggest “a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and from the second position to the first position.” Jones, cited for a teaching of a coin bag 52 and coin bag holder, has not been shown to make up for this deficiency.

Accordingly, it is submitted that the combination of Hino and Jones fails to identically teach or suggest each and every element of claim 3 and, in view of at least the foregoing remarks, Applicant respectfully requests reconsideration and withdrawal of this rejection.

III. THE 35 U.S.C. § 103 REJECTION OF CLAIMS 5, 7-9, 14-16, 25-27, AND 33-34

Claims 5, 7-9, 14-16, 25-27, and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner (US 4,450,968) (“Muellner”). Reconsideration and withdrawal of this rejection is requested.

A. CLAIMS 5-16

Claims 5-16 recite, *inter alia*, “a coin receptacle station disposed within the housing for holding a plurality of coin receptacles, the coin receptacle station including a plurality of

individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first position and a second position, each moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first position, each moveable platform extending out of the housing when in the second position” and “a track along which each moveable platform rides when moving from the first position to the second position and from the second position to the first position,” “wherein each of the moveable platforms is slideably disposed directly over a corresponding track.”

Hino shows a single coin receptacle 120 on casters 122b (FIG. 4). Muellner shows a shopping cart return rack having a track 24 into which a wheel 42 of a cart 14 may enter from one side and exit from an opposing side. Neither Hino nor Muellner disclose or suggest, for example, “a track along which each moveable platform slides when moving from the first position to the second position and from the second position to the first position,” “wherein each of the moveable platforms is slideably disposed directly over a corresponding track.” Instead, the track 24 of Muellner is disposed to an extreme lateral side of the cart 14 so that the wheel 42 extending outwardly from a lateral rear side of the cart can enter the track. When combined with Hino, even if Hino were redesigned into a cart-like configuration shown, the alleged movable platform 122 of Hino would still not disclose or be suggestive of the claimed moveable platforms being “disposed directly over a corresponding track”. Further, Hino relies upon casters and Muellner upon wheels. Casters and wheels are configured to roll, not slide. Neither Hino nor Muellner disclose or suggest “a track along which each moveable platform slides”. Instead, the wheel of Muellner rolls inside the track.

Hino fails to disclose or suggest (and Muellner certainly does not disclose or suggest), for example, a “coin receptacle station including *a plurality of individually moveable platforms* each having at least one coin receptacle disposed thereon” (emphasis added). Instead, Hino show only a single drawer 122. The Examiner again argues, in reliance upon MPEP § 2144.04(VI)(B) and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) cited therein, that individually moveable platforms in Hino would be a mere duplication of parts and, therefore, would have been obvious to one of ordinary skill in the art. The court in *In re Harza* stated that “[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here.” *Id.* Although this is not a *per se* rule, the Examiner is improperly treating it as such and has not set forth any evidentiary basis upon which this conclusion may be legitimately founded. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), “reliance on *per se* rules of obviousness is legally incorrect and must cease.” For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner must, and has failed to, explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See In re Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. For at least the above reasons Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness of claims 5, 7-9 and 14-16 under 35 U.S.C. § 103(a).

B. CLAIMS 14-16

Claims 14-16 depend from claim 5 and are submitted to be patentable over the combination of Hino and Muellner for at least the reasons noted above.

Further, specifically as to claims 14-16, for example, the Examiner states that Hino discloses a “door (122a)” with an “open position (FIG. 4)” and a “closed position (FIG. 2).”

The “broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.*” *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)(*italics added*). The Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized the “broadest reasonable interpretation” standard, stating that:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).

415 F.3d at 1316, 75 USPQ2d at 1329. See also *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

The claims, of course, do not stand alone, but are rather part of “a fully integrated written instrument,” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995) (*en*

banc), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). For that reason, claims “must be read in view of the specification, of which they are a part.” *Id.* at 979.

In the Examiner’s previous “Response to Arguments,” the Examiner states that “[t]he wall is a door since it is a ‘movable panel (122a in FIG. 2 and 4) for closing off an entrance (See FIG. 4, opening near 116)’” (*citing Webster’s II Dictionary, Office Edition, 3rd Ed., Houghton Mifflin Company, 2005*). The Examiner’s interpretation of this claim notably omit any mention of Applicant’s specification and appear not to be viewed in light of the specification. It is submitted, therefore, that one skilled in the art would not have reasonably interpreted “door” in the manner asserted by the Examiner. It is again noted that the more expansive Webster’s II New College Dictionary (Houghton Mifflin Company, 1995) defines “door” as a “movable structure for closing off an entrance, *typically consisting of a panel that swings on hinges, slides, or rotates*” (emphasis added).

In the Examiner’s current “Response to Arguments,” the Examiner quotes, yet appears to misunderstand, Applicant’s prior statement that:

(1) Contextually, as presented by the Examiner, the term “door” would appear to encompass a hood of a car, a tent flap, or a window, or even a warning sign disposed prominently in a hallway, items which are not typically associated with the terminology “door.” Such a reading would not objectively appear reasonable.

Inexplicably, in view of these statements, the stated that “Applicant asserts (1) is reasonable”. Applicant does not contend that the Examiner’s interpretation of “door” is reasonable. Applicant was specifically noting that the Examiner’s interpretation of door is not reasonable by any objective standard.

Hino fails to show a housing comprising “a door moveable between an open position and a closed position, the door permitting a moveable platform to move from the first position to the second position when the door is in the open position.” The front wall 122a has itself neither an open position nor a closed position and does not permit the moveable drawer to move from a first position to a second position “when the door is in the open position.”

Notwithstanding the Examiner’s factual error and misapplication of the law, Applicant is further amending claims 14-16 to make more explicit that which is already claimed to ensure that there can be no misinterpretation, to expedite prosecution, and/or to place the claims in even better form for appeal. Specifically, claims 14-16 now recite that the moveable platforms move relative to the door. There is no relative movement between the front wall 122a of Hino and the wheeled drawer 122 of which the front wall is a part.

Reconsideration and withdrawal of this rejection is requested.

C. CLAIMS 25-27

Applicant submits that claims 25-27 are patentable over the combination of Hino and Muellner for at least the reasons noted above. Further, the combination of Hino and Muellner fails to disclose or suggest the combination of features claimed.

The combination of Hino and Muellner fails to disclose or suggest the elements of claims 25-26 which recite, *inter alia*, “[a] method for processing coins with a coin processing machine comprising a housing, a coin sorting unit disposed within the housing, and a plurality of moveable coin receptacle platforms each bearing at least one coin receptacle, the coin receptacle platforms each being disposed over a track and each being independently moveable on the track from a first position to a second position and from the second position to the first position, each coin receptacle platform being disposed entirely within the housing for receiving coins when in

the first position, each coin receptacle platform extending out of the housing when in the second position.” This method comprises the acts of “receiving a plurality of coins of a plurality of denominations to be sorted,” “sorting the plurality of coins according to denomination with the coin sorting unit,” “sliding one of the plurality of moveable coin receptacle platforms bearing at least one coin receptacle along the track from the first position to the second position for accessing the at least one coin receptacle borne thereby,” “removing coins from the at least one coin receptacle while the moveable coin receptacle platform is in the second position,” and “sliding the moveable coin receptacle platform from the second position to the first position along the track.”

As to claim 26, again notwithstanding the Examiner’s factual error and misapplication of the law, Applicant is further the claim to make more explicit that which is already claimed to ensure that there can be no misinterpretation, to expedite prosecution, and/or to place the claims in even better form for appeal. The combination of Hino and Muellner fails to disclose or suggest the elements of claim 26 which recites, further to the method of claim 25, the acts of opening a door of the housing prior to moving any coin receptacle platform and moving, only subsequent to the opening of the door of the housing, a coin receptacle platform from the first position to the second position.

The combination of Hino and Muellner fails to disclose or suggest the elements of claim 27 which recites a coin processing device, comprising a “coin receptacle station disposed within the housing for holding a plurality of coin receptacles each for receiving discharged coins of a single denomination, the coin receptacle station including a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon, each moveable platform being moveable between a first operable position and a second inoperable position, each

moveable platform being disposed entirely within the housing for receiving coins in the at least one coin receptacle disposed thereon when in the first operable position, each moveable platform extending out of the housing when in the second inoperable position,” and “a plurality of tracks, each of the plurality of individually moveable platforms being disposed to slide from said first operable position to said second inoperable position and from said second inoperable position to said first operable position along a corresponding one of said plurality of tracks.”

Reconsideration and withdrawal of this rejection is requested.

IV. THE 35 U.S.C. § 103 REJECTION OF CLAIMS 10, 12-13 AND 30 AND THE 35 U.S.C. § 103 REJECTION OF CLAIMS 11 AND 31

Claims 10, 12-13, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner and further in view of Jones, *et al.* (US 6,318,537) (“Jones”). Claims 11 and 31 were likewise rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner and further in view of Jones.

Claims 10, 12-13 depend from claim 5 and claim 30 depends from claim 27 and are submitted to be patentable over the applied combination of references for at least the reasons noted above. Reconsideration and withdrawal of this rejection is requested for at least the reasons noted above.

It is further noted that obviousness requires a teaching that all elements of the claimed invention are found in the prior art and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the

legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007)(citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)); see also *Ex parte Smith*, 83 USPQ2d 1509, 1515 (Bd. Pat. App. & Int. 2007). The mere fact that references can be combined or modified does not itself render the resultant combination obvious. Hino mentions no deficiencies or problems associated with the use of casters 122b for coin drawers and Muellner relates to wheels not casters. Muellner discloses no generally applicability of the disclosed subject matter to anything other than carts used for baggage, packages and groceries. There is no evidence of record supporting the proffered combination, nor has any articulated reasoning with any rational underpinning been advanced in support the legal conclusion of obviousness. Instead, the Examiner merely sets forth a generalized assertion. The Examiner’s burden to set forth a *prima facie* case of obviousness has not been discharged, as broad conclusory statements, standing alone, are not “evidence” supportive of a *prima facie* showing. See *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993).

Reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of claims 10, 12-13 and 30-31 is therefore requested at least upon the above-noted grounds.

V. CONCLUSION

It is the Applicants’ belief that all of the claims are in condition for allowance and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Should any fees be required (except for payment of the issue fee) that have not otherwise been expressly authorized and/or paid, the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247171-000390USPT.

Respectfully submitted,

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